

REMARKS

Claims 1-41 are now pending in the application. The amendments to the claims contained herein are of equivalent scope as originally filed and, thus, are not a narrowing amendment. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Grainger (U.S. Pat. No. 2002/0161733; "Grainger 1") in view of "Declaration of Use of Mark in Commerce under § 8 (15 U.S.C. § 1058); Grainger (U.S. Pat. No. 2002/0091542; "Grainger 2") and further in view of Fields (U.S. Pat. No. 2002/0069154. This rejection is respectfully traversed.

The following comments apply to claim 1 and to each other independent claim likewise.

(i) Concerning the combination of the documents:

"Declaration of use of mark in commerce under § 8 (15 U.S.C. § 1058), 5/99"

With the documents

US-2002/0161733. Grainger 1

US-2002/0091542, Grainger 2

US-2002/011824. Grainger

US-2002/0069154. Fields

The applicant respectfully submits that this combination does not advance the case for the presently claimed invention being obvious, because the document

"Declaration of Use" provides no nearer a starting point for the presently claimed invention, than any of the other cited patent documents.

In particular, the document "Declaration of Use", does not disclose the feature of: "Storing component cost data relating to a plurality of component costs of said registered trade mark applications in a plurality of territories."

In the "Declaration of Use" document, there is only one territory, this being the United States taken as a whole. The document relates to Federal trade marks.

There is no teaching in "Declaration of Use" of storing costs for a plurality of countries.

There is no suggestion in the "Declaration of Use" document to store component costs for a plurality of countries.

The "Declaration of Use" document relates the payment of renewal fees, no the filing of trade mark applications. Since the problem addressed in the "Declaration of Use" is not the filing and prosecution of trade mark applications, there would be no motivation on the part of the ordinary person to use that document as a starting point for calculating a cost for the filing and / or prosecution of a trade mark application.

(ii) US 2002/0161733 (Grainger 1) discloses a list of territories (figure 4b), however that disclosure is in relation to annuities only, and to patents only. It is unrelated to trade marks.

There is no suggestion in Grainger 1 to combine the teaching of that document with "Declaration of use". Grainger 1 relates to patents and inventions, whereas "Declaration of use" relates to trade mark declaration of use. There is no need for a declaration of use for patents. There is no reference in either document to the other document.

Further, there is no motivation to combine the teaching of Grainger 1 with the teaching of "Declaration of use" with a view to reaching the presently claimed invention, since there is no suggestion in either document of the other document.

The problems addressed in the present invention are not the same as, nor related to the problems addressed in "Declaration of use" of Grainger 1.

(iii) The "Declaration of Use" document also has the same limitations of Grainger 2 – US 2002/0091542, both of the documents being restricted to annuity fees (renewal/maintenance fees).

There is no suggestion in Grainger 2 to combine the teaching of that document with "Declaration of use". Grainger 2 relates to patents and invention collection. whereas "Declaration of use" relates to trade mark declaration of use. There is no need for a declaration of use for patents. There is no reference in either document to the other document.

Further, there is no motivation to combine the teaching of Grainger 2 with the teaching of "Declaration of use" with a view to reaching the presently claimed invention, since there is no suggestion in either document of the other document.

The problems addressed in the present invention are not the same as, nor related to the problems addressed in the "Declaration of use" or Grainger 2.

(iv) It has been pointed that neither Grainger 1.2 nor any of the other prior art citations raised in this prosecution deal with the issue of either attorney fees or official fees in relation to priority claims, seniority claims or designations of states. That is also the case for newly added citations "Declaration of Use".

(v) Further, there is an important point in relation to annuity fees that the claimed invention claims:

"A method of calculating a cost data relating to a cost of a registered trade mark application, said method...".

The document "Declaration of Use" referred to by the Examiner relates to payment of a fee which is due after registration of a trade mark and is therefore outside the scope of the claimed invention.

(vi) Grainger 2 shows calculation of renewal fees (annuities) for patents in Fig 5. It does not disclose:

"calculating substantially in real time said calculated cost data relating to a cost of said registered trade mark application from said stored component cost data and

said data describing at least one territory and said data describing a number of classes of goods/services."

A problem addressed by the present disclosure is the efficient filing of a registered trade mark application. At the filing stage renewal (annuity) payments for trade marks are not a consideration, since in general the first annuity payment is not due until 10 years after filing. There is no teaching of calculation of trade mark filing cost data in Grainger 2. The ordinary skilled person would not be motivated to look at Grainger 2 when addressing the problem of trade mark filing, since Grainger 2 relates to patents only. Although Grainger 2 states that it relates to "other intellectual property documents" rights in [0004], these other IP documents are patent related correspondence, concerned with the prosecution of patent applications.

There is no suggestion in Grainger 2 to combine the teaching of that document with the "Declaration of use".

Further, there is no motivation to combine the teaching of Grainger 1 with the teaching of "Declaration of use".

The applicant upholds their remarks and observations as set out on page 14 of the preliminary amendment dated August 20, 2007.

(vii) Furthermore, the applicant submits that even with the inclusion of the document "Declaration of Use" there is no motivation from the combined teaching of any of the prior art document of record, to modify Grainger 1, Grainger 2, or any other prior art document, including "Declaration of Use" to include variation of real time calculated cost in response to data concerning the territory.

In particular, in the case of document "Declaration of Use", the territory is fixed and invariable and relates to a single territory only.

(vii) In the present office action summary (mailed October 31, 2007), the Examiner contends that.

"it would have been obvious to one of ordinary skilled in the art at the time of the invention to modify Grainger 1 to include the step of input of inputting the number of classes of goods/services as is normally applicable in the registration of trade mark applications for appropriate fee calculation".

However, the applicant sees no suggestion in Grainger 1 that input of the number of classes would be of use or benefit in Grainger 1. Grainger 1 teaches away from considering trade marks at all. see for example [0002] "The present invention relates....Intellectual property documents such as patent applications. ..including pending patent applications and issued or granted patents. "The whole granger 1 document teaches exclusively the handling of patents. Even though there is reference to "securing intellectual property rights" at [0002], thereafter in the document the teaching is solely concerned with patents.

(ix) In the instant office action, the Examiner contends in relation to Grainger 1 and Grainger 2:

"Grainger 2 teaches calculating substantially in real time said calculated cost data relating to a cost of said registered trade mark application from said stored component cost data and said data describing at least one territory and said data

describing a number of classes of good/services (Fig 5; section 0011). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grainger 1 to include this step as taught by Grainger 2. One would have been motivated to do this in order to provide a total cost of registering the trade marks application."

The applicant sees no teaching of "calculating substantially in real time said calculated cost data relating to a cost of said registered trade mark application from said stored component cost data" in Grainger 2, which relates to renewal fees for patents.

There is no teaching of "said data describing a number of classes of good/services (Fig 5; section 0011)" in Grainger 2 as recited by the examiner. The passage and figure referred to by the examiner describes patent annuity fees. being post grant matters. not pre registration matters for trade marks. There is no teaching of "a number of classes of goods and services" in Grainger 1 or in Grainger 2.

The application respectfully requests that the above objection should be withdrawn.

(x) Grainger 2 has no suggestion within it to combine its teaching with "Declaration of Use".

There is no motivation for the ordinary person to combine the teaching in Grainger 2 with "Declaration of Use". because Grainger 2 relates to post registration matters for patents. not pre registration matters for trade marks.

(xi) The Examiner also contends:

"Fields teaches wherein said calculated cost data represents a real time running total transaction cost for said registered trade mark application. said calculated cost data changing substantially in real time on modifying said data describing a number of goods/services of said registered trade mark application (fig. 33. 36A-36B. Section 0043, 0046-0047, 0078, 0096). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grainger 1 to include this step as taught by Fields. One would have been motivated to do this in order to generate a customized fee quote based on the number of classes of goods/services.

The teaching of Fields relates to an online system whereby patent attorneys can bid for work on the basis of fee cost. Fields does not teach "said calculated cost data represents a real time running total transaction cost for said registered trade mark application. said calculated cost data changing substantially in real time on modifying said data describing a number of goods/services of said registered trade mark application".

In particular, there is no teaching of the "cost data changing substantially in real time on modifying said data describing a number of goods/services." Figures 20 and 21, which relate to the entry of trade mark information makes no mention of the number of classes of goods and services in the application.

Since the step is not taught in Fields, there is no motivation to combine Fields with Grainger 1 and even if Fields is combined with Grainger 1. it does not result in the above step.

(xii) The Examiner has also noted:

"The Examiner notes that the fee for the number of classes of goods/services is considered as part of Government fees required for registration. Therefore a customized fee quite for an application having a single class (\$100x1=\$100) would be different for the customized fee quote having 20 classes (\$100x20 = \$2,000)."

While the above statement may be true in isolation, in Fields the system is unaware of how many classes of goods and services the trade mark application will apply to, and therefore not enough information is collected to provide an accurate cost. The Fields disclosure is one of the class of prior art disclosures which has shortcomings which the present application solves. In practice the Fields system would not work to give a reliable quote, because it takes no account of the number of classes of goods and services.

The ordinary person would not be motivated to combining Fields with Grainger 1. to arrive at the claimed invention. because making such a combination does not arrive at all of the features of the claimed invention.

(xiii) The applicant respectfully suggests there is no motivation to combine Grainger 1. Grainger 2. Fields and "Declaration of Use". because those documents do

not address the problem set out at [0007] of the present application of variable costs for trade mark applications and variable costs for different countries for the same application, and the problem of the cost of the application varying with the number of different classes of goods and services.

(xiv) The applicant submits that a combination of the four independent documents "modified Grainger" does not result in all of the features of claim 1. In particular, the teaching of "cost data changing substantially in real time on modifying said data describing a number of goods/services" is missing.

(xv) The Examiner cites the combination of Grainger 1, Grainger 2, "Declaration of Use" and Fields thereafter as being referred to "modified Grainger".

The applicant observes in relation to modified Grainger, that it includes the teaching from four separate sources, three of which are independent. The applicant respectively submits that the larger the number of sources cited in a combination, the more unlikely it is that the skilled person in the art would concoct a combination from those sources. There are no pointers within the four documents to each other.

The applicant respectfully submits that the Examiner's modified Grainger combination has an element of *ex post facto* analysis after the state of mind of the skilled person at the time of the invention, and submits that the skilled person would not seek to combine those four separate sources. In any case a combination of the four sources does not who arrived at the claimed invention.

Further, the concept of combining four independent documents into a single citation, "modified Grainger" in respect of claims 2-33 is a wholly artificial construct, and in itself very non probable.

As a matter of fact the inventors were unaware of the Grainger documents, the Field document and the "Declaration of Use" document at the time of the invention.

As a practical matter, the inventors were in fact not actually motivated to even find, let alone combine four of the citations at the time of the invention.

Further, on the point of motivation to combine documents, the inventors at the time of the invention were (and still are) busy persons and did not spend time searching for prior art documents, reading the documents, or making informed selections as to which elements of those documents to combine. If anything, faced with such a task, the inventors at the time of the invention would have been motivated to give the whole exercise up as an unproductive time sink.

(xvi) In this case the applicant respectfully submits that the examiner has applied unjustified enthusiasm in combining independent prior art documents, and is effectively applying what amounts to an ex post facto analysis in determining obviousness. The "teaching, suggestion, motivation" (TSM) test applies that a patent composed of several elements is not proved obvious merely by demonstrating that each element was independently known in the prior art (KSR).

In this case, the Examiner applies to combine four prior art documents into one, and treats (Grainger 1, Grainger 2, Declaration of use and Fields[s] as a single prior art citation, referred to as modified Grainger". The applicant respectfully submits that

construction of such a combination of independent prior art documents is inconsistent with the TSM doctrine following KSR, and that as a practical matter it would not be obvious to make such a construction of prior art.

The applicant respectfully submits that the argument for obvious combination recedes significantly for any more than two combined citations. Never the less, in this case even with a combination of four independent citations, all of the features of amended claim one are still not found in the prior art cited by the examiner.

(xvii) The inventors' motivation fact was based on a desire to provide a way around the problem of variable cost per trade mark application as an inhibiting aspect of providing on-line automated trade mark services. See [0007] and [0008] of the application as published.

Part of the inventive step in the present application is realizing that the non-provision and/or difficulty of provision of cost information for filing and prosecution of registered trade mark applications was in practice in inhibiting on-line trade mark filing activities. Therefore, to a certain extent an inventive step lies in realizing the technical and practical problems in automating a service in the first place.

The applicant submits that the invention is patentable and that the requirements of the statute are complied with. Further and favorable reconsideration of the application, and grant of the patent is requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

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Respectfully submitted,

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